

In the Application of:  
Walter KUHN et al.  
Serial No.: 10/565,241

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The below undersigned attorney contacted the Examiner to clarify the present action as a non-final office action. The Examiner indicated that the present action is in fact a non-final action and the box was mistakenly checked as being a final office action.

**Rejection of Claims under 35 U.S.C. § 112**

Claims 1-2, 4-5, 7, 9 and 11-18 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. The claims have been amended where necessary. With respect to the Examiner's rejection of claim1, it is believed that the claim definitely recites limits in terms of percentages (based on weight) for the cis and trans material. Withdrawal of this rejection is respectfully requested.

**Rejection of Claims under 35 U.S.C. § 102**

Claims 7 and 9-18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Eliel et al. The Examiner states that Eliel et al. discloses making the cis acetate.

The publication of Eliel et al. discloses exclusively the production of cis-3,3,5-trimethylcyclohexyl acetate. No other cis-3,3,5-trimethylcyclohexyl ester is disclosed or suggested. The rejected claims as amended specifically exclude cis-3,3,5-trimethyl-cyclohexyl acetate.

As Eliel et al. fails to disclose or suggest each and every element as recited in the independent claims, it cannot anticipate those claims. Thus, withdrawal of the 35 U.S.C. §102(b) rejections is respectfully requested.

**Rejection of Claims under 35 U.S.C. § 102/103**

Claims 1-2 and 4-5 stand rejected under 35 U.S.C. §102(b) as being anticipated by Behura et al. (as evidenced by Chowdhury et al.). Alternatively, these claims are rejected under 35 U.S.C.

§103(a) as being unpatentable over Behura et al. As the Examiner acknowledged, Behura discloses the use of Curcuma longa and, as evidenced by Chowdhury et al., C. longa 0.55% of cis-3,3,5-trimethylcyclohexyl acetate. The Examiner admits that “the reference [Behura] does not disclose the amount of a Claimed trans material” but that Behura “does not indicate that the material does not comprise a trans component” and concludes that trans material exists in an amount less than the cis material. (Action, p.5-6). Applicants respectfully disagree with the Examiner’s conclusions.

Applicants’ claimed mixture includes one or more cis-3,3,5-trimethylcyclohexyl esters and one or more trans-3,3,5-trimethylcyclohexyl esters. As the Examiner stated, Behura discloses C. longa, which, according to Chowdhury et al., includes only cis-3,3,5-trimethylcyclohexyl acetate at 0.55%. However, nowhere does Behura disclose or suggest a mixture including one or more cis-3,3,5-trimethylcyclohexyl esters and one or more trans-3,3,5-trimethylcyclohexyl esters, as claimed. The Examiner has provided no support for the conclusion that “[a]s Behura et al. does not indicate that the material does not comprise a trans component, the material is taken to comprise a trans component of 3,3,5-trimethylcyclohexyl acetate less than the corresponding cis chemical” other than the assertion that “nature would be expected to allow for variations in chemical compositions.” (Action, p. 5-6). However, such conclusions cannot support a rejection under obviousness. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (quoting Federal Circuit statement with approval). Here, there is no support for the Examiner’s conclusions regarding disclosure of the trans material. Nowhere do

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the cited references disclose a mixture of the cis and trans material. Outside of the fact that "nature" might allow for such a combination, the Examiner is kindly requested to provide support for the conclusion that a mixture of the cis and trans material is disclosed.

As the Examiner has failed to support the rejection of claims 1-2 and 4-5, the rejections based on the same must be withdrawn. Thus, withdrawal of the rejection of claims 1-2 and 4-5 is respectfully requested.

Prompt and favorable examination on the merits is requested.

For the Applicants,



Rajiv S. Shah  
Registration No. 56,247

Roylance, Abrams, Berdo & Goodman, L.L.P.  
1300 19<sup>th</sup> Street, NW Suite 600  
Washington, D.C. 20036-2680  
(202) 659-9076